

Inventors: Lucas et al.
Serial Number 09/816148

PATENT APPLICATION
Navy Case No. 79597

Remarks/Arguments

Although the applicant cancelled claims 1-35, the Examiner issued a restriction requirement to the subject matter of Group I claims 1-35 and Group II claims 36-53. In response to this use of cancelled claims, the applicant's attorney had a telephone interview about this procedure with the SPE Nancy Le on September 15, 2003, and this interview has been made of record (see the Interview Summary and Commentary, provided by the applicant). Prior to this interview with the SPE and after the interview with the SPE the applicant also had an interview with the Examiner, which the Examiner has indicated have been made of record but not yet mailed to the applicant. In all of these interviews the Examiner and the SPE affirmed their position that it was proper to use claims 1-35 in making the restriction requirement. The applicant's attorney also spoke with Supervisory Program Examiner Laballe who indicated that he had not reviewed the merits of this restriction requirement and that the requirement appeared to be made on the basis of claims originally presented.

Since claims 1-35 had previously been cancelled and claims 36-53 are pending but have been withdrawn from consideration, the applicant now resubmits these sets of claims as 36-53 and 54-88 so that they will properly be before the examiner if there is to be a final restriction requirement.


The applicant now respectfully traverses and requests that the restriction requirement be withdrawn for the following reasons:

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1. The Examiner states that the inventions of the two groups are independent or distinct.

However, the Examiner has not provided the required analysis to meet the distinctness test for inventions related as combination/subcombination as provided in the MPEP 806.05(c):

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. 

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See **MPEP § 808.02**.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance...

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search.

This situation can be diagrammed as combination AB_{br} ("br" is an abbreviation for "broad"), and subcombination B_{sp} ("sp" is an abbreviation for "specific"). B_{br} indicates that in the combination the subcombination is broadly recited and that the specific characteristics set forth in the subcombination claim B_{sp} are not set forth in the combination claim.

Since claims to both the subcombination and combination are presented and assumed to be patentable, the omission of details of the claimed subcombination B_{sp} in the combination claim AB_{br} is evidence that the patentability of the combination does not rely on the details of the specific subcombination.

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2. While the Examiner has made a bald assertion that the inventions are distinct, the MPEP 808.02 also requires *in addition* to distinctness that the Examiner show by appropriate explanation one of the following:


(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

These additional restriction requirements are followed by the advisory comment in the MPEP 808.02 that “where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, *no reasons exist for dividing among related inventions.*” (Italics added by applicant’s attorney for emphasis.)

3. Finally, the Examiner has referenced MPEP 821.03 as his authority for making the restriction requirement. In reviewing this section, the applicant’s attorney notes that this section specifically provides that after making a restriction requirement using this section, “a complete action on all claims to the elected invention should be given.”



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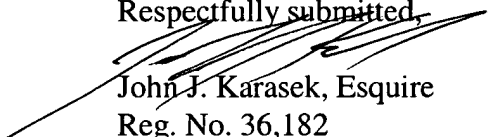
For these three reasons, the applicant's attorney now submits that the Examiner has not met his burden of proof in showing that these claims are directed to separate and distinct inventions and has not shown that they are properly restrictable.

Conclusion


If there is any question or any issue that the Examiner feels may advance the prosecution of this case, the Examiner is asked to telephone the applicant's attorney at the Office of General Counsel of the United States Navy at 202-404-1553.

Kindly charge any additional fees due or credit overpayment of fees to Deposit Account Number 50-0281.

Respectfully submitted,



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